

REMARKS**A. INTRODUCTION**

Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-33 were pending and rejected.

Upon entry of this Amendment:

- Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-34 will be pending
- Claims 1, 10, and 19 will be amended
- Claim 34 will be added
- Claims 1, 8, 9, 10, 17, 18, 19, 26, 32, 33, and 34 will be the only independent claims

B. CLAIM AMENDMENTS

No new matter has been added by any amendment.

1. Claim 1

Although Applicants do not believe the amendment is necessary for patentability, Claim 1 has been amended to recite a feature of *wherein in accordance with a game rule associated with the lottery ticket any one of the plurality of play symbols printed in the play area of the lottery ticket is selectable as an initial player selection.*

2. Claim 10

Although Applicants do not believe the amendment is necessary for patentability, Claim 10 has been amended to recite a feature of *wherein in accordance with a game rule associated with the ticket any one of the plurality of nodes printed in a pattern spanning the play area of the ticket is selectable as an initial player selection.*

3. Claim 19

Claim 19 has been amended to correct some obvious errors noted during a review of the file. Occurrences of “scratch-lottery ticket” have been correctly replaced with *scratch-off lottery ticket.*

C. SECTION 112 REJECTION

The Examiner rejects Claims 26-32 as failing to comply with the written description requirement of Section 112. The Examiner asserts:

The claim now recites that “any one of the nodes is selectable at the start of the game”. Applicants invention shows nodes of start elements 1-6, 108, 110, 112, 114 and finish elements 116, 118,

120, 122, 124. Not “any one” of the nodes are selectable at the start of the game as called for in claim 26. For example one could not select nodes 116, 118, 120, 122 or 124. As such there exists insufficient disclosure for such a limitation.

[Office Action, page 2].

Applicants respectfully disagree. Although some elements of the indicated figure are labeled as “start” and “finish” to convey the game theme of completing a path from one side of a river to another, the player is free, in some embodiments, to select any element, symbol, or node initially, not just those labeled “start.” See, e.g., Specification, page 8, line 31 to page 9, line 9 (emphasis added):

Furthermore, any of the elements on the card 100 can be exposed or selected first by a player without violating the rules of the “CROSS THE RIVER” game. Thus, while at least one of the start elements 106, 108, 110, 112, 114 and at least one of the finish elements 116, 118, 120, 122, 124 must be included in a connected path of elements for the path to render the card 100 a winning card according to the rules 130, a player does not have to pick or choose one of the start elements 106, 108, 110, 112, 114 or one of the finish elements 116, 118, 120, 122, 124 as the player’s first play or exposed element on the card 100. For example, a player could pick the element 154 on the card 100 as the first element on the card 100 that the player exposes.

Applicants respectfully request reconsideration and withdrawal of the Section 112 rejection of Claims 26-32.

D. SECTION 102(E)/SECTION 103(A) REJECTIONS

Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-33 are rejected under Section 102(e) or in the alternative under Section 103(a), in light of assertions allegedly supported by Riendeau (U.S. Patent No. 6,761,633).

Claim 12 is rejected under Section 103(a) in light of Riendeau and Sultan (U.S. Patent No. 6,273,817).

The Examiner has failed to establish a prima facie case of obviousness (or anticipation, which is the epitome of obviousness) for any pending claim.

1. Independent Claims 1, 8, 9, 10, 17, and 18

1.01. Claim 1 is not a product by process claim

Applicants first note the Examiner’s grounds for rejection of at least Claim 1 is based on the determination that Claim 1 is a product by process claim. [Office Action, page 3]. Applicants respectfully traverse this finding. Claim 1, as indicated by its preamble and method steps, is clearly a method or process claim.

Although performing the steps of Claim 1 may result in a product, Claim 1 itself does not claim the product, but only a process. The determination of patentability must be based on the recited process steps, not on an end-product the Examiner believes may be produced by the steps. To the extent the Examiner has failed to determine the proper statutory class claimed in Claim 1, Applicants submit that the Examiner has failed to establish a prima facie case of anticipation or obviousness of Claims 1-3 and 5-9.

Further, Applicants do not believe that any of the pending claims are product by process claims.

1.02. Riendeau does not teach or suggest all of the features of Claims 1, 8, 9, 10, 17, and 18

Claim 1 has been amended and now includes a feature of

- *wherein in accordance with a game rule associated with the lottery ticket any one of the plurality of play symbols printed in the play area of the lottery ticket is selectable as an initial player selection*

Claims 8 and 9 incorporate by reference the above limitation of Claim 1.

Claim 10 has been amended and now includes a feature of:

- *wherein in accordance with a game rule associated with the ticket any one of the plurality of nodes printed in a pattern spanning the play area of the ticket is selectable as an initial player selection*

Claims 17 and 18 incorporate by reference the above limitation of Claim 10.

Applicants respectfully submit that in Riendeau not any one of the plurality of play symbols or nodes in a play area of a ticket is selectable by a player as an initial player selection.

To the contrary, Riendeau suggests that not any one of the play symbols or nodes is selectable at the start of the games in Riendeau. As explained in Riendeau, a player must make a first selection at the start of the game from one of designated “nodes”—not any one of the depicted “nodes” or points in the play area may be selected at the start of the game. A player could not, for example, first select a “finishing point” in Riendeau or some other mid-point in the displayed branches. [See, e.g., Abstract (“as play progresses between a starting point and multiple finishing points”); FIG. 1, FIGs. 2A-2B (“START” 52); Column 7, lines 1-4 (“According to a sample game, the player’s current position is marked using a marker (herein depicted as a star) at a starting point 52 (see FIG. 2A). From there the player must choose between a first branch 62 and a second branch 64.”) (emphasis added)].

Sultan does not suggest the above features; the Examiner does not assert otherwise.

The Examiner has not established with substantial evidence that all of the features of independent Claims 1, 8-10, 17, or 18 were known or desirable. Accordingly, the Examiner has not established a prima facie case of obviousness for Claims 1 (and its dependent Claims 2, 3, and 5-7), 8, 9, 10 (and its dependent Claims 11-13, 15, and 16), 17, or 18. We respectfully request that the Examiner withdraw the Section 102(e)/103(a) rejection of Claims 1-3, 5-13, and 15-18.

2. Independent Claims 19 and 26

Claim 19 includes a feature of

- *wherein any one of the nodes [in the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

Claim 26 includes a feature of

- *wherein any one of the nodes [spanning the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

With respect to Claim 26, the Examiner asserts:

Riendeau shows a pattern of nodes in spaces marked “01” or space marked “16” in his fig. 2A. Any one of these nodes is selectable at the start of the game as called for by claim 26.

[Office Action, page 4].

However, the spaces “01” and “16” are not a pattern of nodes forming a plurality of available paths from the first section of the play area to a second section of the play area, as required in Claim 19; nor are they a pattern of nodes spanning a play area, as required in Claim 26.

In contrast Claims 19 and 26 provide for facilitating play of simulated scratch-off lottery tickets in which any node of a pattern of nodes that either spans a play area or forms a plurality of available paths from the first section of a play area to a second section. The spaces “01” and “16” are individual points that by themselves cannot span the indicated play area nor form paths—single points cannot form paths.

As discussed above, Riendeau suggests that not any one of the indicated play symbols or nodes is selectable at the start of the games in Riendeau. As explained in Riendeau, a player must make a first selection at the start of the game from one of designated “nodes”—not any one of the depicted “nodes” or points in the play area may be selected at the start of the game. A player could not, for example, first select a “finishing point” in Riendeau or some other mid-point in the displayed

branches. [See, e.g., Abstract (“as play progresses between a starting point and multiple finishing points”); FIG. 1, FIGs. 2A-2B (“START” 52); Column 7, lines 1-4 (“According to a sample game, the player’s current position is marked using a marker (herein depicted as a star) at a starting point 52 (see FIG. 2A). From there the player must choose between a first branch 62 and a second branch 64.”) (emphasis added)].

Sultan does not suggest the above features; the Examiner does not assert otherwise.

The Examiner has not established with substantial evidence that all of the features of independent Claims 19 or 26 were known or desirable. Accordingly, the Examiner has not established a prima facie case of obviousness for Claim 19 (and its dependent Claims 20, 21, and 23-25) and Claim 26 (and its dependent Claims 27 and 29-31), 32, and 33. We respectfully request that the Examiner withdraw the Section 102(e)/103(a) rejection of Claims 19-21, 23-27, and 29-33.

3. Claims 2 and 11

We disagree with the Examiner’s assertion:

Claim 2 merely calls for “causing at least one void symbol to be printed...” with no further structure. A “void symbol” is most broadly any symbol. Nothing in claims 2 or 11 recite any structure that distinguishes over the interpretation of the symbols in Riendeau with negative signs as being considered to be “void symbols”. Applicant argues how Riendeau plays his game. However, as set forth above [presumably referring to the argument that Claim 1 is a product by process claim], the play of the game fails to distinguish over the applied art.

[Office Action, page 3].

Applicants still do not understand the Examiner’s reasoning, and request further explanation. We do not agree that one of ordinary skill in the art would have considered “any symbol” or symbols “with negative signs” as *void symbols*. The Examiner has not provided any evidence in support of this assertion as to what was known in the prior art. Nor does the Examiner appear to have ascertained that his interpretation is consistent with Applicants’ disclosure, as is required in presenting a reasonable interpretation of claim terms.

The Examiner still has not even asserted that Riendeau teaches symbols that cause paths to be non-continuous paths or indicate discontinuity. Neither Sultan nor Riendeau teach such features. To the contrary, it is clear that a player playing the Riendeau game continues along a path even if the revealed number is negative (i.e., a prize decrement). The alleged (and unsupported) need to “bypass” a node

that would result in a prize decrement does not suggest that the existence of “negative points” causes non-continuity of any path. The rejection of Claims 2 and 11 fails for at least this reason.

Applicants respectfully traverse any requirement that Claims 2 and 11 recite “structure.” Claims 2 and 11 are directed to method claims. Regardless, contrary to what is implied by the Examiner, structural and process limitations may be described in terms of functionality. Further, the claims clearly require printing of symbols in such a manner as to provide for potentially continuous paths to be non-continuous paths and to provide for printed symbols that indicate discontinuities in paths. Riendeau does not suggest any such functionality or printed symbols.

We respectfully request the Examiner withdraw the Section 102(e)/103(a) rejection of Claims 2 and 11.

4. Additional Comments

Our silence with respect to the Examiner’s other various assertions, including assertions of what Riendeau and Sultan teach or suggest, of what is “inherent” in Riendeau, of what would have been obvious in light of Riendeau and/or Sultan, and of what would have been “well known” or “obvious” to do, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case of obviousness for any of the pending claims, for the reasons stated above, we need not address the Examiner’s other assertions at this time.

E. NEW CLAIM 34 CONTAINS ALLOWABLE SUBJECT MATTER

New method claim 34 includes a feature of *establishing a rule of a game in which any one of a plurality of printed play symbols spanning a play area of a lottery ticket is selectable as an initial player selection in the game.*

Neither Riendeau nor Sultan, alone or in combination, teaches or suggests such a feature.

Applicants respectfully request allowance of new Claim 34.

F. SECTION 101 ISSUES

No Section 101 rejections appear to be present in this application. The Examiner asserts:

With respect to the issues under 101, the steps of “causing a plurality of symbols to be printed” to be the same as “printing a plurality of symbols. Such are considered to be physical steps that render a product by the process.

[Office Action, page 3].

It is not clear to which claim the Examiner is directing this comment, but Claim 1 recites steps of *causing a plurality of symbols to be printed* and *causing a plurality of links to be printed*. In contrast, Claim 10, for example, recites a step of *printing a plurality of links*.

Applicants wish to clarify for the record that *causing to be printed* and *printing*, as those terms are used in the Specification and the claims, are not identical in scope. In some embodiments *causing to be printed* may comprise *printing*, but Claim 1 also encompasses embodiments in which an entity may cause a plurality of symbols to be printed but does not perform the printing itself (e.g., one company instructs another company to print a plurality of symbols).

To the extent the Examiner believes the terms are analogous in the sense that they are sufficient for the purpose of identifying eligible subject matter under Section 101, Applicants do not agree or disagree. It is also not clear what the Examiner considers “physical steps,” but Applicants submit that all of the pending claims are directed to practical applications (i.e., every claim produces a useful, concrete, and tangible result).

G. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner’s early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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